REMARKS/ARGUMENTS

Claims 1-6, 8, 10-14, 16-22, and 25-40 are pending in the present application. None of the claims has been amended. However, a Listing of Claims has been included for convenience. Claims 1, 8, 14, 19, 27, and 32 are the only independent claims.

I. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-6, 14, 16-21, 25-33, 36-37, and 40 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,842,698 to Brown ("Brown") in view of U.S. Patent No. 6,517,073 B1 to Vancura ("Vancura"), U. S. Patent No. 7,169,041 B2 to Tessmer *et al.* ("Tessmer"), U.S. Patent Application Publication No. 2004/0248651 A1 to Gagner ("Gagner"), and U.S. Patent No. 6,755,741 to Rafaeli ("Rafaeli").

Claims 8, 10-13, and 34-35 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Brown in view of Vancura, Tessmer, Gagner, and Rafaeli and further in view of U.S. Patent No. 6,155,925 to Giobbi ("Giobbi").

Claims 22 and 38-39 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Brown in view of Vancura and Tessmer as applied to claims 21 and 32 above, and further in view of U.S. Patent No. 6,210,275 to Olsen ("Olsen).

II. Disqualification of Gagner Under 35 U.S.C. § 103(c)

All the independent claims have been rejected based on a combination of references that includes Gagner. However, for subject matter that qualifies as prior art under 35 U.S.C. §§ 102(e), (f), or (g), 35 U.S.C. § 103(c) prevents such subject matter from being used in a § 103

obviousness analysis, if "the subject matter and the claimed invention, were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." Manual of Patent Examining Procedure, Rev. 6, Sept. 2007, § 706.02(l)(1), p. 700-54, *quoting* 35 U.S.C. § 103(c)(1).

A. Gagner is prior art under 35 U.S.C. § 102(e)

The present application was filed on July 2, 2003. Gagner was filed on June 3, 2003 (about one month prior to the present application) and was published on December 9, 2004. Thus, Gagner qualifies as prior art under 35 U.S.C. § 102(e).

B. Common Ownership

THE PRESENT APPLICATION AND GAGNER WERE, AT THE TIME THE INVENTION OF THE PRESENT APPLICATION WAS MADE, BOTH SUBJECT TO AN OBLIGATION OF ASSIGNMENT TO A COMMON ASSIGNEE, WMS GAMING INC.

In addition to the above statement regarding common ownership, the Applicant notes that an assignment for the present application was recorded at Reel/Frame No. 014260/0371, and an assignment for U.S. Patent Application Publication No. 2004/0248651 was recorded at Reel/Frame No. 014156/0698. These two recorded assignments convey the entire rights in the present application and in U.S. Patent Application Publication No. 2004/0248651 to the same entity: WMS Gaming Inc.

Therefore, 35 U.S.C § 103(c) applies and a rejection under section 103 cannot be made using Gagner. Accordingly, the Applicants respectfully request that the rejection under 35 U.S.C. § 103 against all the pending claims be withdrawn.

III. Rafaeli Fails To Disclose A Non-Eligible Player

Rafaeli was cited along with Gagner for allegedly teaching that "non-eligible players would be able to make side wagers on the predicted outcome of the dice roll." Specifically, the Office Action alleged that "Rafaeli teaches a dice game wherein players who are not rolling the dice (involved in the event) may wager on the outcome of the dice and participate in a passive manner through the wagering of side bets." The players that do not roll the dice are not "non-eligible" players as claimed in the pending claims.

The claimed "eligible" player is the only player that is eligible to win a progressive award during a progressive game. In contrast, the claimed "non-eligible" player is not eligible to receive the progressive award from the progressive game. Rafaeli discloses two types of players: (1) one type of player that rolls the dice, and (2) one type of player that wagers "with respect to dice thrown by another player." Rafaeli, col. 9, ll. 35-38. Both types of players in Rafaeli are "eligible" players because they are both wagering with respect to the dice outcome.

Thus, the Applicants respectfully submit that Rafaeli fails to support the proposition for which it was cited, *i.e.*, that it discloses a non-eligible player.

IV. Subsequent Office Action MUST Be A Non-Final Office Action

The Applicants respectfully note that none of the claims has been amended in the current response. Additionally, the two new references that were added in the current Office Action (Gagner and Rafaeli) fail to properly support the rejections for the above stated reasons. Thus, the Applicants note that the next Office Action – if further rejections are presented by the Examiner – must be a non-final Office Action.

V. Conclusion

It is the Applicants' belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fee is presently due. However, should any fees be required, the Commissioner is authorized to deduct the fees (except for payment of the issue fee) from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000207USPT.

Respectfully submitted,

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